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END5005USNPRemarksStatus of Claims

Claims 1-20 were rejected. Claims 1-3 have been amended. All of the amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

Office Addressing Unclaimed Subject Matter

In the Office Action dated 07/13/2007, the Office again appears to address claims that are not actually being prosecuted in the present application. For instance, in purporting to reject claims 1, 2, and 4-18, the Office purports to find teachings in the prior art of:

a system and method for detecting tissues comprising a detector, a substance for associating with a target tissue where the substance is capable of being detected by the detector and a machine for verifying at least one of the detector and substance are suitable for use.

(Office Action dated 07/13/2007, page 2). Such subject matter simply is not recited in any of the present claims, and Applicant has no intention for such subject matter to be read into the claims. Indeed, every one of the present claims recites only methods – no systems or apparatuses are recited. To the extent that the Office believes that such subject matter is found in the present claims, the Office is respectfully requested to point out where in the claims such subject matter may be found. For instance, which claim recites anything relating to “a machine for verifying at least one of the detector and substance are suitable for use?” Otherwise, the Office is respectfully requested to focus its analysis on the actual claim language being presented in this application.

§103 Rejections

Claims 1, 2, and 4-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kovacs et al. (U.S. 5,833,603) in view of Adair et al. (U.S. 6,750,037). Claim 3 was rejected over Adair et al. in view of Iddan et al. (U.S. 5,604,531) and Goldenberg (U.S. 5,716,595). Claims 19-20 were rejected over Kovacs et al. in view of Adair et al. and Iddan et al.

Under MPEP 2143.03, in order to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest all of the limitations of a claim. A *prima facie* case of obviousness also requires that there be some teaching, suggestion, or motivation to modify the references either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01. The mere fact that references can be combined or modified does not

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render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143.01. *Actual evidence* of a suggestion, teaching or motivation to combine prior art references must be shown. *In re Dembiczak*, 50 USPQ2d 1614 (Fed.Cir. 1999). Broad *conclusory statements*, standing alone, simply *are not evidence*. *Id.* Motivation to combine or modify will be lacking if the art teaches away from a claimed combination. MPEP 2145. For at least the reasons set forth below, Applicant respectfully submits that the combined art of record fails to render any of present claims 1-20 obvious.

Applicant submits that the art of record fails to teach or suggest all of the limitations recited in each independent claim in accordance with MPEP 2143.03. For instance, Applicant notes that amended independent claim 1 recites directing a detector through a patient's entire gastrointestinal tract to detect signals as the detector passes through the patient's gastrointestinal tract. These limitations, among others recited in amended claim 1, are neither taught nor suggested by the combined art of record. Applicant therefore submits that the combined art of record fails to teach or suggest all of the limitations of amended claim 1 in accordance with MPEP 2143.03. Accordingly, Applicant respectfully submits that the combined art of record fails to render present claim 1 obvious in accordance with MPEP 2143, and respectfully requests that the rejection be withdrawn.

Amended independent claim 2 recites directing a material that comprises at least one signal emitting substance through a patient's gastrointestinal tract, and detecting signals emitted by the substance with a detector as the detector passes through the patient's gastrointestinal tract. These limitations, among others recited in amended claim 2, are neither taught nor suggested by the combined art of record. Applicant therefore submits that the combined art of record fails to teach or suggest all of the limitations of amended claim 2 in accordance with MPEP 2143.03. Accordingly, Applicant respectfully submits that the combined art of record fails to render present claim 2 obvious in accordance with MPEP 2143, and respectfully requests that the rejection be withdrawn.

Amended independent claim 3 recites providing a display that indicates the detection of a target cell type as detected by a detector in relation to the associated position of the detector within a patient's gastrointestinal tract. These limitations, among others recited in claim 3, are neither taught nor suggested by the combined art of record. Applicant therefore submits that the combined art of record fails to teach or suggest all of the limitations of claim 3 in accordance with MPEP 2143.03. Accordingly, Applicant respectfully submits that the

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combined art of record fails to render present claim 3 obvious in accordance with MPEP 2143, and respectfully requests that the rejection be withdrawn.

Even if all of the references in combination taught or suggested all of the limitations recited in the amended claims, the Office has failed to establish the motivation to modify or combine the teachings of the references as required by MPEP 2143, and has instead relied upon impermissible hindsight reconstruction in declaring the claimed invention obvious. Indeed, MPEP 2143.01 admonishes that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (emphasis in original). *Actual evidence* of a suggestion, teaching or motivation to combine prior art references must be shown. *In re Dembiczak*, 50 USPQ2d 1614 (Fed.Cir. 1999). Broad *conclusory statements* regarding the teaching of references, standing alone, simply *are not evidence*. *Id.* Rather than being based in evidence in the record, the motivation provided by the Office appears to be based solely on a subjective opinion of an individual examiner rendered nearly 6 years after the priority/filing date of the present application. This falls far short of the requirements of MPEP 2143.01. *See In re Dembiczak*, 50 USPQ2d 1614 (Fed.Cir. 1999). Ultimately, the Office has failed to provide the requisite *evidence* in the prior art suggesting the desirability of the combinations claimed herein. Because the motivation required by MPEP 2143.01 is lacking, Applicant respectfully requests that the rejections be withdrawn.

Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for non-obviousness.

Conclusion

While several distinctions have been noted over the art of record, Applicant notes that there are several other limitations recited in the present claims that are neither taught nor suggested by the art of record. Applicant expressly reserves all rights and arguments with respect to distinctions not explicitly noted herein. In addition, to the extent that the amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. To the extent that any particular statement or argument by the Office in the pending Office Action has not been explicitly addressed herein, the same should not be construed as an acquiescence or admission by the Applicant that such statements or arguments by the Office are accurate or proper.

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Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully submitted,

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